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LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER LEROUX, ETIENNE PIERRE	
			ART UNIT 2161	PAPER NUMBER

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/805,534

Applicant(s)

SIEGEL ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-9, 12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-9, 12, and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### ***Continued Examination***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/2004, has been entered.

### ***Claim Status***

Claims 1, 2, 4-9, 12, 14-18 are pending. Claims 3, 10, 11 and 13 have been canceled. Claims 1, 2, 4-9, 12 and 14-18 are rejected as detailed below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites “changing at least one of the characteristic values.” The specification does not contain a clear and concise description of the manner in which “one of the characteristic values” is changed such that a skilled artisan can make and use the invention.

Claims 2, 4 and 5 are rejected for being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “associating the identity of a first entity with at least one of the codes.” There is insufficient antecedent basis for “the identity” and furthermore “the codes.”

Claim 1 recites “indicating whether an entity is authorized to receive changes relating to the first or second characteristic associated with the code.” There is insufficient antecedent basis for “the code.”

Claim 1 recites “changing at least one of the characteristic values.” There is insufficient antecedent basis for “the characteristic value.”

Claim 1 recites “retrieving the identity of the first entity based on the changed value.” There is insufficient antecedent basis for “the changed value.”

Claim 1 recites “associating the identity of a first entity with at least one of the codes including setting one or more update values indicating whether an entity is

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authorized to receive changes relating to the first or second characteristics associated with the code.” The scope of the invention cannot be determined because it is difficult to determine if “a first entity” is comparable to “an entity.”

Claims 2, 4 and 5 are rejected for being dependent from a rejected base claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-9, 12 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No. 5,913,210 issued to Call (hereafter Call ‘210), as best examiner is able to ascertain.

**Claim 1:**

Call ‘210 discloses:

- associating a first code [universal product code and first Internet address per col 3, lines 48-60] with a first characteristic of a product and a second code [universal product code and second Internet address per col 3, lines 48-60] with a second characteristic of the same product,
- storing a first characteristic value associated with the first characteristic and a second characteristic value associated with the second characteristic [registration handler, Fig 2, item 203]

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- associating the identity of a first entity with at least one of the codes including setting one or more update values indicating whether an entity is authorized to receive changes relating to the first or second characteristics associated with the code [col 3, lines 48-60],
- changing at least one of the characteristic values [col 4, lines 34-37, col 6, lines 22-30, col 8, lines 32-42],
- retrieving the identity of the first entity based on the changed value and one of the one or more update values [col 6, lines 31-42, col 10, lines 46-56]
- determining whether the first entity is informed of updates based on one of the one or more update values [col 10, lines 33-37]
- sending the changed value to the first entity [col 3, lines 48-55, col 8, lines 32-42, col 6, lines 31-42]

Claim 4:

Call '210 discloses sending the change by email [col 4, lines 44-52 and col 7, lines 7-10]

Claim 5:

Call '210 discloses retrieving the electronic address of the first entity [col 4, lines 10-26]

Claim 6:

Call '210 discloses:

- providing product data associating information codes to information about a product [col 3, lines 48-60],

- providing destination data correlating the information codes to entities [col 4, lines 10-26],
- storing an entity - data association [col 3, lines 48-60]
- modifying the information about the product [col 4, lines 34-37, col 8, lines 32-42]
- identifying a first entity based upon the information code associated with the information about the product, the product data and the destination data [col 3, lines 48-60]
- determining whether the first entity is informed of the modified information based on the entity-data association [col 10, lines 33-37]
- transmitting the modified information about the product to the first entity [col 3, lines 48-55 and col 8, lines 32-42]

Claim 7:

Call '210 discloses wherein the modified information is transmitted over a network and the first entity is a computer on the network [Fig 1, items 120 and 103]

Claim 8:

Call '210 discloses wherein the network is the Internet [col 2, lines 28-33]

Claim 9:

Call '210 discloses wherein the product is a service [col 2, lines 33-47]

Claim 12:

Call '210 discloses:

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- means for associating a first code [first Internet address per col 3, lines 48-60] with a first characteristic of a product and a second code [second Internet address per col 3, lines 48-60] with a second characteristic of the same product,
- means for storing a first characteristic value associated with the first characteristic and a second characteristic value associated with the second characteristic [Fig 2, item 203]
- means for associating the identity of a first entity with at least one of the codes [col 3, lines 48-60],  
means for changing at least one of the characteristic values [col 4, lines 34-37 and col 8, lines 32-42]
- means for retrieving the identity of the first vendor based on the changed characteristic value [col 3, lines 48-60]
- means for determining whether the first entity is automatically informed of updates based on one of the one or more update values[col 10, lines 33-37]
- means for sending the changed value to the first vendor in response to the determination [col 3, lines 48-55, col 8, lines 32-42, col 6, lines 31-42]

Claim 14:

Call '210 discloses wherein the means for sending the changed value comprises means for sending the value by email [col 7, lines 7-30].

Claim 15:

Call '210 discloses:

- a processor [Fig 1, item 103]



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- data instructions [Fig 1, item 103] executable by the processor, the instructions including:
- associating a first code with a first characteristic of a product and a second code [second Internet address per col 3, lines 48-60] with a second characteristic of the same product [first Internet address per col 3, lines 48-60];
- storing a first characteristic value associated with the first characteristic and a second characteristic value associated with the second characteristic [Fig 2, item 203]
- associating the identity of a first entity with at least one of the codes [col 3, lines 48-60];
- changing at least one of the characteristic values [col 4, lines 34-37, col 8, lines 32-42];
- retrieving the identity of the first entity based on the association with the code associated with the characteristic with the changed value [col 6, lines 31-42];
- determining whether the first entity is informed of updates based on one of the one or more update values [col 10, lines 33-37]
- sending the changed value to the first entity [col 6, lines 31-42]

Claim 16:

Call '210 discloses wherein the system comprises a server connected to a network and the first entity comprises another server on the network [col 3, line 60 through col 4, line 10]

Claim 17:

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Call '210 discloses wherein the system comprises a server connected to a network, the data is maintained by a seller, and the first entity is a buyer of the product from the seller [Fig 1 and abstract].

Claim 18:

Call '210 discloses wherein the product is a service [col 2, lines 33-47]

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,913,210 issued to Call (hereafter Call '210), as best examiner is able to ascertain.

Claim 2:

Call '210 discloses the elements of claim 1 as noted above. Call '210 fails to disclose associating the identity of a second entity with the same code as that associated with the first entity, retrieving the identity of the second entity based on the code associated with the characteristic having the changed value, and sending the changed value to the second entity. However, Call '210 discloses the product codes and the Internet addresses are provided by or on behalf of participating manufacturers and suppliers [col 2, lines 50-52]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Call '210 to include associating the

identity of a second entity with the same code as that associated with the first entity, retrieving the identity of the second entity based on the code associated with the characteristic having the changed value, and sending the changed value to the second entity. The ordinarily skilled artisan would have been motivated to modify Call '210 per the above for the purpose of controlling the scope and content which a manufacturer makes available [col 8, lines 32-35].

### ***Response to Arguments***

Applicant's arguments filed 10/22/2004 have been fully considered but they are not persuasive.

#### **Applicant Argues:**

Applicant states in the fourth paragraph of page 9 "In contrast, claims 1 and 15 recite 'determining whether the first entity is informed of updates based on one of the one or more update values.' [ ..... ] Applicants respectfully submit that Call does not disclose, teach or suggest in any way the foregoing limitation as is recited in claims 1, 6, 12 and 15. Therefore, applicants respectfully submit that for at least this reason, these claims are not at all anticipated by Call. Furthermore, inasmuch as all of the remaining claims depend from either claims 1, 6, 12 or 15, applicants respectfully submit that the remaining claims are also not anticipated by Call or obviated by Call or any combination of the references relied on by the examiner."

#### **Examiner Responds:**

Examiner is not persuaded. Examiner maintains the following disclosure by Call, column 10, lines 33-38, reads on "determining whether the first entity is informed of updates based on one of the one or more update values."

**For most manufacturers, these structured data files, both individual record files in the subdirectories and the combined file in the root directory, may be automatically created and updated on a periodic or dynamic basis from the content of the manufacturer's existing database.** The use of a single combined file at each server permits multi-manufacturer database to be created by first retrieving the IP-addresses of all or part of the cross-reference table 215, and then retrieving and merging the combined data files from the "/upcinfo" directories from each identified server. Alternatively, when information about all of a given manufacturer's products of a give type is not desired, the needed individual structured data files can be retrieved from the individual product directories.

Call discloses server-based structured data files which dynamically interface with a manufacturer's local database. These server-based structured data files form part of Call's product code translator 101 (refer Fig 1, 103). Examiner maintains that Call's server-based structured data files are comparable to the claimed first entity. The above disclosure by Call teaches that the server-based structured data files are automatically created and periodically updated based on the latest product information obtained from the database of a participating manufacturer. Therefore, Call discloses that a first entity is updated per changes occurring in a participating manufacturer's local database.

Furthermore, Call discloses in column 13, lines 20-22, terminals and kiosks which are placed in retail stores, showrooms and public places to provide product information. Such terminals which are stand-alone, are obviously automatically updated with the latest product data via the server which houses the product code translator. Call discloses a second situation where an entity (the terminals and kiosks) are informed of updates per the above claim limitation.

**Applicant Argues:**

Applicant states in the paragraph joining pages 8 and 9 “In accordance with this embodiment of Call, when a user requests product information, the product code translator 101 returns the requested information to the user without making any determination of whether the user should be informed of the requested information.”

**Examiner Responds:**

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., returns the requested information to the user without making any determination of whether the user should be informed of the requested information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

**Applicant Argues:**

Applicant states in the second paragraph on page 9, “Thus, a user is provided the requested information regardless of whether the user is authorized to receive the information.”

**Examiner Responds:**

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a user is provided the requested information regardless of whether the user is authorized to receive the information) are not recited in the rejected claim(s). Although the

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claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

However, considering the claim limitation “indicating whether an entity is authorized to receive changes,” examiner maintains the following disclosure by Call, i.e., column 4, lines 34-58, is relevant:

The registration handler process preferably incorporates a mechanism or procedure for insuring that the registrant has the authority to create and alter the information being supplied. A variety of methods for enhancing the security of the registration process may be employed, including the issuance of a password at the time a range of universal product codes is first registered, with the requirement that the same password be thereafter provided by anyone who seeks to alter the information originally provided with respect to any product code within that previously registered range. The registration procedure may also require each registrant to provide an email contact address to which an email message of predetermined content is sent after the initial registration form is completed, to which the registrant must respond within a predetermined time to verify the registration. Any attempt thereafter to change the contact email address results in a message being sent to the originally registered email contact address advising that an attempt is being made to alter the registration. Finally, email confirmation may be requested from the email address registered with InterNIC for the URL to which universal product codes are to be linked. This step confirms that the person attempting a registration in fact has authority to link to that host computer and provides an additional safeguard against unauthorized submissions.

#### **Applicant Argues:**

Applicant states in the third paragraph on page 9 “Further, in this regard, applicants respectfully submit that nowhere in Call is it disclosed or suggested that a determination should be made regarding whether a user should be informed of information that is requested.”

#### **Examiner Responds:**

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a determination should be made regarding whether a user should be informed of information that is requested) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Patent related correspondence can be forwarded via the following FAX number  
(703) 872-9306

Etienne LeRoux

1/3/2005

  
SAFET METJAHIC  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100